

In paragraph 10, page 4 of the Office Action, claims 56-57 have been rejected under 35 U.S.C. § 112, first paragraph. Claim 56 recites, in part:

the vertices of each hoop pointed in the axial direction lie in a common plane perpendicular to the longitudinal axis of the tubular member.

Paragraph 10 of the Office Action contends that

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claims 56-57 recite "the vertices of each hoop pointed in the axial direction lie in a common plane perpendicular to the longitudinal axis of the tubular member" which is not disclosed in the specification.

Applicants' response (in the Request for Reconsideration dated September 29, 2005) to a similar previous § 112 rejection identified substantial support in the application for the claimed recitation.

In response, paragraph 2, page 2 of the present Office Action states, in part:

Examiner acknowledges the cited passages to recite the end hoops being perpendicular to the longitudinal axis, but this does not provide support for the limitation "the vertices of each hoop pointed in the axial direction lie in a common plane perpendicular to the longitudinal axis of the tubular member." (emphasis in original)

Applicants respectfully disagree.

Page 9, lines 13-19 of Applicants' specification states:

In some embodiments the wire may have a helical configuration as disclosed in EP-A-0556850. Alternatively, the wire may be of an entirely novel configuration, namely one in which the wire forms a plurality of hoops such that the plane of the circumference of each hoop is substantially perpendicular to the longitudinal axis of the stent." (emphasis added).

Page 23, lines 11-23 and particularly lines 20-23 describe a portion of "[t]he construction of the exemplary proximal part 12 of the bifurcated stent 10." It states:

Each hoop 20 is wound onto mandrel 46 such that the plane of the circumference of each hoop 20 is substantially perpendicular to the longitudinal axis of the mandrel. (emphasis added)

Finally, page 44, lines 19-23 states:

Two embodiments of such straight stents are described herein, each comprising axially aligned stent requests, each of the requests comprising one or more adjacent hoops, perpendicular to a common axis. . . . (emphasis added)

Contrary to the Office Action's statement, these portions of the specification are not limited to a description of only the end hoops of the stent. Instead, they unequivocally refer to "each hoop" and "each" request. There is no basis in the specification (and the Office Action has not pointed to anything in the specification) to support the Office Action's assertion that these passages of the specification apply only to end hoops.

In addition, the § 112 rejection is based solely on what the PTO contends is an insufficient specification. It fails to consider Applicants' entire disclosure, including the figures. Applicants again refer to their Figures 1A, 1B, 2A, 2B, 3, 4A, 5-7, and 15-20.

As stated in MPEP 2163 II. A. 3(a):

Possession may be shown in many ways. . . Possession may also be shown by a clear depiction of the invention in detailed drawings. . . which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention. An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. . . An applicant may show possession of an invention by disclosure of drawings. . . that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. . . [D]rawings alone may provide a written description of an invention as required by Sec. 112. . . In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.

(internal quotations omitted, citations omitted).

The above figures, in combination with the specification, would "permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention." Despite the requirement of *Dickinson v. Zurko*, 527 U.S. 150 (1999); *In re Hyatt*, 211 F.3d 1367, 1371-1372 (Fed. Cir. 2000); and *In re Gartside*, 203 F.3d 1305 (Fed. Cir. 2000), the Office Action has failed to produce substantial evidence demonstrating that such a person would not clearly recognize that Applicants had possession of the claimed invention.

Accordingly, Applicants respectfully request that this rejection of claim 56 and dependent claim 57 be withdrawn. Since claim 56 has not been rejected based upon prior art, it is respectfully submitted that claims 56 and 57 are now in condition for allowance.

Claim 54 and dependent claims 20, 22-24 have been alternatively rejected as anticipated by one or more of Cragg (U.S. Patent No. 5,405,377); Fontaine (U.S. Patent No. 5,370,683); Wolff (U.S. Patent No. 5,104,404); and Furui (JP 4-25755) under various subsections of 35 U.S.C. § 102. Dependent claims 25, 31-33, 39, 41, 43, 44, 47, and 55 have